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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/879,823	BARNETT ET AL.
	Examiner	Art Unit	
	Arthur Duran	3622	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *31 October 2007*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *47,52 and 63* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *47 and 52 and 63* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

    1. ☐ Certified copies of the priority documents have been received.

    2. ☐ Certified copies of the priority documents have been received in Application No. _____.

    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 47 and 52 and 63 have been examined.

Response to Amendment

2.   The Amendment filed on 10/31/07 is insufficient to overcome the rejection.

Examiner further notes that this office action is in response to the February 8, 2006

decision by the Board of Patent Appeals and Interferences (BPAI) which affirmed the

Examiner in the rejection of the claims.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR

1.17(e), was filed in this application after final rejection. Since this application is eligible for continued

examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the

finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's

submission filed on 10/31/07 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
> manner in which the invention was made.

3.   Claims 47 and 52 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Von Hohorn (5,227,874) in view of Saigh (5,734,823).

Claims 47, 52:

VonKohorn discloses:

storing, at an network-accessible location, information pertaining to a group of available

coupons, including information about one or more target audiences of users for which one or

more coupons have been designated (col 98, lines 39-45; col 98, lines 57-65; col 105, lines 15-

30);

prompting a user to register over the network to be able to print coupons, if the user is not

already registered;

receiving registration information from the user (col 3, line 56-66; col 94, lines 1-12; col

94, lines 56-62; col 97, lines 64-70; col 103, line 62-col 104, line 2; Fig. 30; col 109, lines 10-

16);

downloading to the computer a unique identifier (col 109, lines 10-16);

receiving, at the network-accessible location, a request from the user for access to at

least some of the stored coupon information, wherein the unique identifier is transmitted with the

request, and one or more routines are implemented at the network- accessible location to confirm

the unique identifier to ensure validity (claims 5 and 6);

displaying coupon information for at least the one or more coupons designated for at

least one of the audiences for which the user is a member (col 98, lines 39-45; col 98, lines 57-

65; col 105, lines 15-30)

receiving selection information from the user for one or more coupons that the user

desires to print based on the displayed coupon information (col 98, lines 39-45; col 98, lines 57-

65; col 105, lines 15-30);

printing, via a printer associated with the computer, one or more user-selected coupons

based at least in part on instructions from the coupon data management software which is

invoked when a user selects a print command (Fig. 30); and

monitoring redemption of the one or more user-selected coupons to prevent fraud

(col 17, lines 10-31; col 20, lines 38-44; col 86, lines 10-25; col 87, lines 59-65).

Von Kohorn further discloses the coupon data management software being used at least

in connection with the printing of coupons (col 109, lines 10-16).

Also, Von Kohorn discloses enabling a user to download coupon data management

software to the at least one remote user computer system to be used at least in connection with

the printing of coupons.

Von Kohorn discloses downloading or transmitting instructional signals and

programming routines (col 2, lines 55-60; col 109, lines 10-16; col 14, lines 20-25; col 20, lines

57-65; col 26, lines 45-52; col 6, line 56-col 7, line 27).

Von Kohorn further discloses that the programming instructions are ordered as a module

or in a group (col 5, lines 31-45; col 4, line 21-35; col 41, liners 28-60).

Von Kohorn further discloses that the programmed response unit can print incentives (col

2, lines 52-56; col 39, lines 24-31; col 41, lines 52-60; col 19, lines 29-34; col 20, lines 57-64;

col 22, lines 49-55; col 34, line 67-col 35, line 6).

Also, Von Kohorn discloses that the user's system is specified as a remote system (Fig. 2;
page 20, lines 7-11). Furthermore, the printer's are associated with the user's system (page 16,
lines 5-10).

Also, Von Kohorn discloses that instructional signals can be transmitted for managing or
adjusting coupons:

"(85) The latter method has the advantage that a sponsor or advertiser can have up-to-
date promotional information printed on <u>coupons</u> by directing the station which transmits
<u>instructional</u> signals to remote locations to include in such signals the desired advertising
material. A last-minute-telephone call by an advertiser to the sub-carrier station with directives
to incorporate certain <u>instructional</u> signals in the sub-carrier transmission will result in a large
number of shoppers being alerted to special sales through up-to-the-minute <u>coupon</u> promotions"
(col 19, lines 29-39).

Hence, Von Kohorn discloses downloading or transmitting instructional signals and
programming routines where the programming instructions can be ordered as a module or in a
group that is utilized for coupon adjusting, coupon managing, coupon printing which is
functionally equivalent to downloading to the one or more remote user systems an incentive data
management software module.

Also, Von Kohorn further discloses that the method can utilize a variety of networks (col
44, line 45-col 45, line 15; col 88, line 55- col 89, line 15).

Von Kohorn does not explicitly disclose that the communication channel can be the
Internet.

However, Saigh discloses the utilization of the Internet for the dissemination of a variety

of information (col 1, lines 38-41; col 5, lines 20-30), that coupons can be transmitted to users

(col 14, lines 60-65; col 8, lines 3-6; col 14, line 15-col 15, line 10) and that the coupons can be

printed (col 8, lines 59-61).

Saigh further discloses that the service system is associated with an Internet web site (col

14, lines 15-21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to add Saigh's utilization of the Internet to Von Kohorn transmitting

coupons. One would have been motivated to do this because the Internet is a readily available

network for transmitting information.

Von Kohorn does not explicitly disclose wherein the unique identifier is encrypted and

transmitted with the request, and one or more routines are implemented at the Internet-

accessible location to decrypt the unique identifier to ensure validity.

However, Von Kohom discloses the utilization of encryption related to identifying indicia

(col 10, lines 40-45) and Von Kohorn discloses encoding and decoding (Fig. 7, 'Coder'; Fig. 8,

'Decoder').

Von Kohorn further discloses the user transmitting the unique user identifier and also that

the user identifier can be a code (col 61, lines 34-55; col 105, lines 51-65; claims 5, 6). Von

Kohorn further discloses that codes, encoding, and encryption are related (col 10, lines 40-45).

And, Saigh further discloses utilizing encryption or encoding (col 15, lines 10-16; claim

10; col 15, line 10-col 17, line 32). Also, Saigh in Figure 12 discloses utilizing the User's ID and

Serial Number in 2nd Level Encryption procedures. And, Saigh Figure 8 discloses that a

customer enters a site and that a user id and pin or password are entered and transmitted to a central site (Figure 8). And, Saigh discloses reading an encrypted user id and password (Saigh, claim 10). Saigh further discloses transmitting an encoded user id to a central site (col 9, lines 33-64 and col 10, line 40-col 11, line 19; col 9, lines 50-60).

And, Saigh discloses a variety of encryption techniques and that a variety of information that is communicated or transmitted can be encrypted (col 15, line 35-col 17, line 33; col 15, lines 37-47; col 15, line 59-col 16, line 10; col 17, line 20-33)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Von Kohorn transmitting of unique user identifiers in the form of codes can also be in the form of encryption. One would have been motivated to do this in order to better secure the communications of the unique identifier of the user.

Alternatively, Von Kohorn discloses encoding and decoding (Fig. 7, 'Coder'; Fig. 8, 'Decoder'). Von Kohorn discloses the central station encoding and the response unit (user unit) decoding. And, as noted above, Von Kohorn discloses that encoding, and encryption are related (col 10, lines 40-45). And, the MPEP 2144.04 VI discloses that reversal or duplication is an obvious modification. Hence, reversing Von Kohorn so that the user unit encodes and the central station decodes is an obvious modification. Or, duplicating the encoder of the central station into the user unit and duplicating the decoder of the user unit into the central station is an obvious modification. And, in regards to Saigh, it is obvious that the encryption of transmission that occur from the central site to the user site can also occur for transmissions from the user site to the central site. Hence, transmitting the unique user identifiers in encrypted form is an obvious form of reversal or duplication.

4.   Claims 47 and 52 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Von Hohorn (5,227,874) in view of Saigh (5,734,823) in view of [Crawford (6,411,943) OR

Crawford (7,080,051)].

Please see the rejections stated above.

And, note the addition of the Crawford reference to the rejection stated above.

Von Kohorn does not explicitly disclose encrypting the transmitted unique user identifier.

However, Crawford (6,411,943) discloses encrypting the transmitted unique user

identifier (claim 14).

Alternatively Crawford (7,080,051) discloses encrypting the transmitted unique user

identifier (Claim 1; also, see claim 3 preamble; and, claims 3, 10, 13-17 and 20-22).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made that Von Kohorn's transmitted unqiue identifier can be encrypted. One

would have been motivated to do this in order to better secure the validity of the unique identifier

of the user.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are not found

persuasive. Please see the comments below.

On page 7 of the Applicant's Remarks dated 10/31/2007, Applicant states that that

combination of the prior art does not render obvious, "wherein the unique identifier is encrypted

and transmitted with the request, and one or more routines are implemented at the Internet-accessible location to decrypt the unique identifier to ensure validity".

Examiner notes that the BPAI decision dated 5/19/2006 for related case 09/321,597 addressed these related features on pages 17-20. However, Examiner notes that at that time that the KSR vs. Teleflex decision was not in existence. And, Examiner notes that related cases 09/543,735; 09/754,378; and 09/321,597 were all affirmed by the BPAI. And, Examiner also notes that all three of these cases were affirmed by the Federal Circuit and that the briefs presented by the USPTO cited KSR extensively. Hence, KSR can be considered when addressing what is rendered obvious by the prior art.

And, Examiner notes that related patent application number 09/321,597 in claims 158 and 159 has these same features stated preceding. And, Examiner notes that patent application number 09/321,597 went before the Federal Circuit. And, Examiner notes that the Federal Circuit affirmed the USPTO in the rejection of patent application number 09/321,597. And, Examiner notes that the Federal Circuit has already affirmed the USPTO in the rejection of claims 158 and 159 utilizing the same Von Kohorn and Saigh references rejection. **Hence, the Federal Circuit has already affirmed the rejection of these features utilizing Von Kohorn and Saigh.**

And, when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that

instance the fact that a combination was obvious to try might show that it was obvious under §103.

If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007).

Also, KSR states that it is obvious to recite combination which only unite old elements with no change in their respective functions and which yield predictable results. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

KSR forecloses the argument that a specific teaching, suggestion, or motivation is require to support a finding of obviousness. See the Board decision *Ex parte Smith*, -- USPQ2d --, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396).

In regards to hindsight reasoning, Examiner notes that rigid preventative rules that deny factfinders recourse to common sense are neither necessary under our case law nor consistent with it. KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007).

And, in this case, Von Kohorn does not explicitly disclose wherein the unique identifier is encrypted and transmitted with the request, and one or more routines are implemented at the Internet-accessible location to decrypt the unique identifier to ensure validity.

However, Von Kohom discloses the utilization of encryption related to identifying indicia (col 10, lines 40-45) and Von Kohorn discloses encoding and decoding (Fig. 7, 'Coder'; Fig. 8, 'Decoder').

Von Kohorn further discloses the user transmitting the unique user identifier and also that the user identifier can be a code (col 61, lines 34-55; col 105, lines 51-65; claims 5, 6). Von Kohorn further discloses that codes, encoding, and encryption are related (col 10, lines 40-45).

And, Saigh further discloses utilizing encryption or encoding (col 15, lines 10-16; claim 10; col 15, line 10-col 17, line 32). Also, Saigh in Figure 12 discloses utilizing the User's ID and Serial Number in 2nd Level Encryption procedures. And, Saigh Figure 8 discloses that a customer enters a site and that a user id and pin or password are entered and transmitted to a central site (Figure 8). And, Saigh discloses reading an encrypted user id and password (Saigh, claim 10). Saigh further discloses transmitting an encoded user id to a central site (col 9, lines 33-64 and col 10, line 40-col 11, line 19; col 9, lines 50-60).

And, Saigh discloses a variety of encryption techniques and that a variety of information that is communicated or transmitted can be encrypted (col 15, line 35-col 17, line 33; col 15, lines 37-47; col 15, line 59-col 16, line 10; col 17, line 20-33)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Von Kohorn transmitting of unique user identifiers in the form of codes can also be in the form of encryption. One would have been motivated to do this in order to better secure the communications of the unique identifier of the user.

Alternatively, Von Kohorn discloses encoding and decoding (Fig. 7, 'Coder'; Fig. 8, 'Decoder'). Von Kohorn discloses the central station encoding and the response unit (user unit)

decoding. And, as noted above, Von Kohorn discloses that encoding, and encryption are related (col 10, lines 40-45). And, the MPEP 2144.04 VI discloses that reversal or duplication is an obvious modification. Hence, reversing Von Kohorn so that the user unit encodes and the central station decodes is an obvious modification. Or, duplicating the encoder of the central station into the user unit and duplicating the decoder of the user unit into the central station is an obvious modification. And, in regards to Saigh, it is obvious that the encryption of transmission that occur from the central site to the user site can also occur for transmissions from the user site to the central site. Hence, transmitting the unique user identifiers in encrypted form is an obvious form of reversal or duplication.

On page 10 of the Applicant's Remarks dated 10/31/2007, Applicant states that Crawford 6,411,943 and Crawford 7,080,051 are non-analogous art. Examiner notes that both Crawford applications share the same parent application history with priority to Application Ser. No. 08/145,825 filed Nov. 4, 1993, now U.S. Pat. No. 5,771,354. Hence, arguments concerning one Crawford application also apply to the other Crawford application.

In response to applicant's argument that Crawford is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, Crawford 7,080,051 is analogous art as demonstrated by the claims of Crawford (see claim 3 preamble; and, claims 3, 10, 13-17 and 20-22). Crawford claim 3 states that Crawford is oriented towards "a system with at least one computer programmed to provide

Internet <u>commercial</u> software services to customers that use a computer with an Internet

connection to receive goods and/or services." And, claims 13-17 of Crawford state that a

variety of different types of commercial data can be downloaded:

"[claim] 13. A system as in claim 10 wherein said data downloaded by said

<u>commercial</u> data downloader includes at least one of software data, information

data, multimedia data, video data, image data, sound data, voice data, word

processing data, electronic mail data, fax data, and print data.

[claim] 14. A system as in claim 10 wherein said data downloaded by said

<u>commercial</u> data downloader is stored as a data file within storage of said

computer users.

[claim] 15. A system as in claim 10 wherein said data downloaded by said

<u>commercial</u> data downloader is accessed by said computer users as a data file.

[claim] 16. A system as in claim 10 wherein said data downloaded by said

<u>commercial</u> data downloader is accessed by said computer users as if the data is

directly accessible by software executing in a computer of said computer users."

Hence, Crawford is oriented to at least one computer programmed to provide Internet

<u>commercial</u> software services to customers that use a computer with an Internet

connection to receive goods and/or services and also the downloading of a variety of forms of

data. Hence, it is obvious in light of the Von Kohorn and Saigh that Crawford's Internet and

secure data downloading features can also be used with Von Kohorn and Saigh's use of the

Internet for secure data downloading.

And, Crawford 6,411,943 has the same parent application as 7,080,051 so both cited Crawford applications are analogous.

On page 11, Applicant states that Crawford is not oriented to unique identifiers related to coupon downloads. However, Crawford is oriented to encrypting unique identifers related to downloads of a variety of data. And, coupons are a form of data that can be downloaded as demonstrated by Von Kohorn and Saigh. And, Von Kohorn and Saigh demonstrate the encryption and also unique identifiers related to coupon downloads. Crawford was added to demonstrate encryption of unique identifiers related to data downloads.

And, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114.

See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The

examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran
Primary Examiner
Art Unit 3622

11/20/2007